

REMARKS

Claims 1-22, 30, 32, 33, 36, 37, 40 and 42-46 are pending in the application.

Claims 1-22, 30, 32, 33, 36, 37, 40 and 42-46 have been rejected.

Claim 42, 43, and 44 have been canceled, without prejudice.

Claims 1, 14-18, 32, 33, 36, 37, 40 and 46 have been amended.

I. REJECTION UNDER 35 U.S.C. § 101

Claim 42 was rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The rejection is respectfully traversed. Applicant has canceled Claim 42 without prejudice. Accordingly, the Applicant respectfully requests withdrawal of the § 101 rejection of Claim 42.

II. REJECTION UNDER 35 U.S.C. § 102

Claims 1-22, 30, 32-33, 36-37, 40, and 42-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lincke (US Patent 6,397,259). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Lincke fails to disclose that its web server 120 performs wireless transmissions to the communications device 100. The web server 140 is illustrated in Figure 1 as communicating with a proxy server 180 which communicates with a base station 170 – all utilizing wireline communications. The base station 170 communicates wirelessly with the communications device 100. “The proxy server 180 decompresses information from the wireless network side for use on the Internet 190 side of the proxy server 180.” Lincke, Col. 11, lines 13-15. Thus, the proxy server

180 does not include functionality to operate as a “wireless router.” Based on this, Lincke fails to disclose each and every element arranged as they are in the claims (taking Claim 1 as an exemplary claim).

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1-22, 30, 32-33, 36-37, 40, and 42-46.

III. REJECTION UNDER 35 U.S.C. § 103

Claims 1-22, 30, 32-33, 36-37, 40 and 42-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gershman (US Patent 6,356,905) in view of Jones (US Patent 6,108, 314). The rejection is respectfully traversed.¹

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

¹ Applicant notes that the prior rejections based on Gershman (US Patent 6,356,905) in view of Perkins (“Simplified Routing For Mobile Computers Using TCP/IP,” IEEE Conference on Wireless LAN Implementation), Gershman in view of Perkins, and in further view of Antonio (US Publication 2002/0098842), and Gershman in view of Perkins, and in further view of Fernandez (EP 0930797), have been withdrawn.

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

The Office Action argues that Gershman teaches each and every element of independent Claims 1, 33, 36, 37, 40, 42 and 43, but that Gershman fails to explicitly disclose use of a wireless router. Office Action, page 3.

As discussed previously in a prior response, Gershman discloses a wireless device 2602, 2713 that generates and transmits a search query message to the wireless server 2606, 2722. The wireless server 2606, 2722 determines the appropriate third party service provider (communicatively coupled to the server 2606, 2722 via the internet or extranet) and transmits a new message thereto. The third party service provider performs the appropriate service and transmits the result back to the server 2606, 2722. The server 2606, 2722 forms a message based on the result and transmits this message to the wireless device 2602, 2713. Gershman, Col. 50, lines 27-55; Col. 56, lines 9-52.

Therefore, it appears that the third party service provider and content providers 2730, not the wireless server 2606, 2722, execute the software application.² Moreover, Applicant's network enabled software applications, as described in the Applicant's specification, do not appear equivalent to the intelligent agents 2724, customer intelligence 2726 or customer data 2728 in the Mobile Portal 2712.

As a result, Gershman not only fails to explicitly describe a wireless router between the first and second devices, Gershman also fails to disclose each and every element as recited and arranged in Applicant's independent claims.

The Office Action further argues that Jones discloses a "mobile computer or devices to communicate over a wireless using a plurality of routers"—pointing to the home network 10, laptop 11, content provider 55 connecting via wireless network using wireless routers 30, 32 (Office Action, page 4) – and therefore it would be obvious to modify Gershman in view of Jones by implementing the system using wireless routers because doing so would have enabled Gershman to operate with less amount of turn-around time. Office Action, page 4.

In view of the deficiencies noted above in connection with Gershman, the proposed Gershman-Jones combination fails to establish a prima facie case of obviousness. However, in order to further prosecution of this application, Applicant has amended independent Claims 1, 33, 36, 37 to recite a first wireless communication link between the first device and the wireless router in accordance with a first wireless protocol and a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol. Applicant has amended independent Claim 40 similarly to recite a first wireless communication link is provided between the packet processing system and the wireless router in accordance with a first wireless protocol and a second wireless communication link is provided between the wireless router and the external device in accordance with a second wireless protocol.

² Though Gershman describes that this configuration "allows the Electronic Valet 2602 to execute many different software applications without the need for a large amount of internal memory and storage capacity", (Col. 50, lines 34-37), the third party service or content providers 2730 of Gershman perform the software execution - not the wireless server 2606, 2722.

The Office Action further argues that Jones teaches such first and second wireless communication links having first and second (different) wireless protocols (citing Jones, Col. 2, lines 54-67). To the contrary, this portion of Jones describes an “alternative” embodiment in which the wireless routers 30, 31, 32 and 33 are connected directly to the global Internet 40 using land-based links such as a FDDI network, 100Base-X links, or an ATM network. Jones, Col. 2, lines 54-59. Thus, this embodiment does not describe a wireless router utilizing wireless communications between itself and the mobile devices and between itself and the global Internet 40.

For the main embodiment described in Jones in which the wireless router utilizes wireless communications links between the end communications devices and other devices in the network, there is no disclosure that the first wireless communication link utilizes a first wireless protocol and the second wireless communication link utilizes a second different wireless protocol. Therefore, there is no teaching or suggestion in Jones to utilize a wireless router between a wireless communication device and a wireless web server (having a plurality of network-enabled software applications executing thereon) wherein the first wireless link between the web server and the wireless router operates in accordance with a first wireless protocol and the second wireless link between the wireless router and the wireless mobile device operates in accordance with a second wireless protocol.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 1-22, 30, 32-33, 36-37, 40 and 42-46.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS CARTER, P.C.

Date: 2/4/2008


Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@munckbutrus.com*